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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SUGHRUE MION ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037			EXAMINER	
			VAN DOREN, BETH	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/888,377	<b>Applicant(s)</b> ONO, MUNETOSHI	
	<b>Examiner</b> Beth Van Doren	<b>Art Unit</b> 3623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11,12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11,12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a Final office action in response to communications received 10/24/2005. Claims 1, 3-4, 8-9, 11-12, 16-18, and 20 have been amended. Claims 2, 10, and 13 have been cancelled. Claims 1, 3-9, 11-12, and 14-19 are now pending in this application.

#### ***Response to Amendment***

2. Applicant's corrections to the drawings are sufficient to overcome the drawing objections set forth in the previous office action.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 9, 12, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 9, 12, and 18 all recite "discussing via a communication network at least one of the gathered business methods, among a conceiver of the business method, the company, and, if appropriate, at least one additional consumer other than the conceiver selected based on confidentiality, potentiality, and/or urgency of starting the business method". It is not clear from the claim limitation as to how one determines when or if the additional consumer(s) is appropriate or not appropriate. For example, based on the claim language, the additional consumer would be determined appropriate and then selected using one or all of confidentiality, potentiality and/or urgency. In another example, the additional consumer is determined appropriate by using one or all of confidentiality, potentiality and/or urgency. Therefore, it is not

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clear as to what is being claimed. Examiner points out that as currently recited, if no additional consumer is appropriate, then the communication occurs only between the conceiver and the company. Clarification is required. For examination purposes, Examiner has construed that the additional consumer is appropriate and that the consumer is selected using one or all of confidentiality, potentiality and/or urgency.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, 4, and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Abelow (U.S. Patent 5,999,908) in view of van Duyne et al. (U.S. 6,859,784).

6. **As per claim 1**, Abelow discloses a method and system for implementing a business method conceived by a consumer by participations of consumers comprising:

- **[Claim 1]** gathering business methods conceived by consumers that coincide with a basic business method concept of a company (col. 13, lines 36-58 and col. 20, lines 28-31, Abelow teaches customers assist developing services offered with the product, such as training, documentation, customer support, financing, volume buy discounts, etc. Customers turn into partners for improving products and services by many means such as improvements in product design, product development, major product upgrades and revisions, improving other product uses, and a variety of business activities; etc.);
- discussing via a communication network at least one of the gathered business methods, among a conceiver of the business method and the company (col. 9, lines 47-59 and 13, lines 36-58, Abelow teaches the defined customers desires may be made available on-line. Sellers and customers engage in an evolving dialog during

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product use. Customers assist defining product features, interfaces, functionalities, etc.); and

- based on said discussion, implementing the at least one business method as an executable method (col. 9, lines 47-59 and 13, lines 36-58, Abelow teaches after engaging the customers in an evolving dialog during product use. Customers assist defining product features, interfaces, functionalities, etc., which are implemented after the discussion).

However, while Abelow discloses implementing a business method conceived by a consumer by participations of consumers, Abelow does not expressly disclose at least one additional consumer other than the conceiver participating in the discussion via the communications network, this at least one additional consumer selected based on confidentiality, potentiality, and/or urgency of starting the business method.

van Duyne et al. teaches multiple online consumers selected by the system and communicating with the system to provide feedback regarding company products and areas of improvement, the consumers selected based on potentiality (col. 3, line 60-col. 4, line 15, col. 5, lines 1-6, col. 10, lines 15-20, wherein in customers are invited to participate based on the customers' profiles, the characteristics of the profile indicating potential for the research and feedback).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the on-line features of van Duyne et al. with the teachings of Abelow since Abelow teaches customers desires may be made available on-line (col. 9, lines 47-59). Time to market is critical for companies in today high technology environment. Abelow teach a customer-based product design module that permits vendors to discover and respond instantly to market shifts and opportunities (Abstract). Van Duyne et al. teaches timely feedback regarding products offered using

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automated means, this feedback useful to product designers and management in meeting the needs of customers (col 10, lines 15-20). Being able to electronically communicate with a group of people reduces the time it takes to reach a consensus on market needs, therefore reducing the time it takes to develop the product and get it to market. Both Abelow and van Duyne et al. teach developing products that meet the customer's needs, therefore there is motivation or suggestion to combine with a reasonable expectation of success. All the claim limitations are taught by the combination of Abelow and van Duyne et al.

**7. As per claims 3 and 4,** Abelow discloses a method and system of consumers comprising:

- **[Claim 3]** the additional consumer is selected from among conceivers of similar business methods and experts in the business field to which the discussed business method relates (Abelow: col. 10, lines 40-49, Abelow teaches the authoring system and data analysis system could turn this architecture into a “point-of-use” distribution system for leading professionals to sell their know-how and services directly to users.).
- **[Claim 4]** selecting one of the business methods implemented as the executable methods by discussing via the communication network, as a core method to be executed (col. 12, lines 43-54, Abelow teaches once a product is on the market the CB-PD Module can be used to accelerate future improvements in the product by means of customer generated suggestions and insights. Specific Customer Design Instruments (CDI) may be used to elicit different information from specific groups of customers (such as by dividing customers functionally by their product uses, or vertically by their market segments).);
- opening to the public via a communication network the core method together with an announcement of gathering proposed business methods conceived by consumers that increase the added value of the core method (col. 12, lines 43-54, Abelow teaches once a product is on the market the CB-PD Module can be used to accelerate future improvements in the product by means of customer generated suggestions and insights. Specific Customer Design Instruments (CDI) may be used to elicit different information from specific groups of customers (such as by dividing customers functionally by their product uses, or vertically by their market segments).); and

- gathering business methods conceived by consumers via a communication network that relate to the core method (col. 12, lines 43-54, Abelow teaches the speed of this system also plays a role in that it communicates back to the product developers, instantaneously in some cases or at least quickly in many cases, the desires of numerous customers that would otherwise not be known or applied.).

8. **Claims 18 and 19** substantially recites the same limitations as that of claim 1 with the distinction of the recited method being a system. Hence the same rejection for claims 1 as applied above applies to claims 18 and 19.

9. **Claims 5-9, 11-12, 14-17, and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Abelow (U.S. Patent 5,999,908) in view of van Duyne et al. (U.S. 6,859,784) and further in view of Harshaw (U.S. Patent 5,542,871).

10. As to claim 5, Abelow and van Duyne et al. together disclose a method and system for implementing a business method conceived by a consumer by participations of consumers but fail to teach the conceiver of the core method becoming at least one of a stockholder and a business partner of the company.

Harshaw teaches the pool manager undertakes efforts to identify and market the new product to potential licensees. The rights granted by the license are given to a manufacturer in exchange for royalties on sales of the new product during the term of the patent (col. 2, lines 18-37). The Examiner interprets the parties are business partners. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the royalty payments of Harshaw with the teachings of Abelow and van Duyne et al. since Abelow teaches users may buy this know-how by purchase order, credit card, etc. (col. 10, lines 3-14). Efficiently getting new products to

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market helps companies improve financial return while decreasing the cost of product development. Abelow teach a customer-based product design module that permits vendors to discover and respond instantly to market shifts and opportunities. By making two-way learning and information delivery part of the product and service environment, vendors or third parties can become faster, more efficient and accurate in designing, delivering and supporting what customers want to buy (Abstract). Harshaw teaches a method for developing new product for introduction into the marketplace, which increases the expectation of financial return and decreases the cost of product development (col. 1, lines 27-38). van Duyne et al. discloses using dialogues with customers about products to gain insight on areas of improvement for products, these dialogues facilitated by a network. Reducing the time it takes to develop the product and get it to market saves time and money, therefore in more efficient and less costly. Abelow, van Duyne et al., and Harshaw teach developing new products, therefore there is motivation or suggestion to combine with a reasonable expectation of success. All the claim limitations are taught by the combination of Abelow, van Duyne et al., and Harshaw.

- **[Claim 6]** a predetermined proportion of profit obtained by executing the core method is shared with the conceiver of the core method (Harshaw: col. 3, lines 62-67, Harshaw teaches a first portion of royalties (e.g. 50%) is distributed to the registrant of the selected idea.).
- **[Claim 7]** a predetermined proportion of profit obtained by executing the core method is shared with the additional consumer who has participated in the discussion (Harshaw: col. 3, lines 62-67, Harshaw teaches a second portion of the royalties that is smaller than the first portion (e.g. 25%) is distributed equally amongst the remaining registrants within the pool.).



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- **[Claim 8]** publicly opening via a communication network information containing the core method, the conceiver of the core method, how the core method was executed, and profit obtained by executing the core method (Harshaw: col. 2, lines 56-67 and col. 3, lines 29-35 and 62-67, Harshaw teaches individuals or small business registrants having a new product idea may register the idea with the appropriate pool. New product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. Each registration includes at least a written description of the idea, concept, or partially developed product. Once an idea has been selected for further development, all registrants are notified of the selection. A first portion of royalties (e.g. 50%) is distributed to the registrant of the selected idea, a second portion of the royalties that is smaller than the first portion (e.g. 25%) is distributed equally amongst the remaining registrants within the pool. The Examiner interprets the process to be a public process where information is communicated.).
- **[Claim 9]** discussing via the communication network at least one of the gathered business methods that relate to the core method, among a conceiver of the business method that relates to the core method, the company, and if appropriate, at least one additional consumer other than the conceiver of the business method that relates to the core method, selected depending on confidentiality, potentiality, and/or urgency of starting the business method that relates to the core method in order to implement the business method as an executable method that increases the added value of the core method (van Duyne et al.: col. 3, line 60-col. 4, line 15, col. 5, lines 1-6, col. 10, lines 15-20, wherein customers are invited to participate based on the customers' profiles, the characteristics of the profile indicating potential for the research and feedback. Harshaw: col. 3, lines 52-56, Harshaw teaches that once a satisfactory degree of proprietary protection is obtained, the selected idea is licensed to a manufacturer. The manufacturer will be granted the right to make, use, sell, and distribute the selected new product in a specified geographic territory.).
- **[Claim 11]** the additional consumer who participates in the discussion of the business method that relate to the core method, is selected from among the conceiver of the core method, conceivers of the similar business methods, and experts in the business field to which the discussed business method relates (Abelow: col. 10, lines 40-49, Abelow teaches the authoring system and data analysis system could turn this architecture into a "point-of-use" distribution system for leading professionals to sell their know-how and services directly to users.).
- **[Claim 12]** selecting one of the business method(s) implemented as an executable method which increases the added value of the core method by discussing via the communication network as an improved method to be

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executed (Harshaw: col. 3, lines 29-35, Harshaw teaches that once an idea has been selected for further development, all registrants are notified of the selection.);

- opening to the public via the communication network the improved method together with an announcement of gathering proposed business methods conceived by consumers that increase the added value of the improved method (Harshaw: col. 2, lines 56-67, Harshaw teaches individuals or small business registrants having a new product idea may register the idea with the appropriate pool. New product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. Each registration includes at least a written description of the idea, concept, or partially developed product.);
- gathering business methods conceived by consumers via a communication network that relates to the improved method (Harshaw: col. 2, lines 56-67, Harshaw teaches individuals or small business registrants having a new product idea may register the idea with the appropriate pool. New product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. Each registration includes at least a written description of the idea, concept, or partially developed product. The Examiner interpret the process is not limited to only new ideas, therefore ideas to improve a known process or product is applicable.); and
- discussing via the communication network at least one of the gathered business methods that relates to the improved method, between a conceiver of a business method that relates to the improved method and the company, in order to implement the business method as an executable method which increases the added value of the improved method (Harshaw: col. 3, lines 52-56, Harshaw teaches that once a satisfactory degree of proprietary protection is obtained, the selected idea is licensed to a manufacturer. The manufacturer will be granted the right to make, use, sell, and distribute the selected new product in a specified geographic territory.).
- **[Claim 14]** the conceiver of the improved method becomes at least one of a stockholder and a business partner of the company (Harshaw: col. 2, lines 18-37, Harshaw teaches the pool manager undertakes efforts to identify and market the new product to potential licensees. The rights granted by the license are given to a manufacturer in exchange for royalties on sales of the new product during the term of the patent. The Examiner interprets the parties are business partners.).

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- **[Claim 15]** a predetermined proportion of profit obtained by executing the improved method is shared with the conceiver of the improved method (Harshaw: col. 3, lines 62-67, Harshaw teaches a first portion of royalties (e.g. 50%) is distributed to the registrant of the selected idea.).
- **[Claim 16]** opening to the public via the communication network information containing the improved method, the conceiver of the improved method, how the improved method was executed, and profit obtained by executing the improved method (Harshaw: col. 2, lines 56-67 and col. 3, lines 29-35 and 62-67, Harshaw teaches individuals or small business registrants having a new product idea may register the idea with the appropriate pool. New product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. Each registration includes at least a written description of the idea, concept, or partially developed product. Once an idea has been selected for further development, all registrants are notified of the selection. A first portion of royalties (e.g. 50%) is distributed to the registrant of the selected idea, a second portion of the royalties that is smaller than the first portion (e.g. 25%) is distributed equally amongst the remaining registrants within the pool. The Examiner interprets the process to be a public process where information is communicated.).
- **[Claim 17]** the communication network is the Internet (Abelow: col. 9, lines 47-49, Abelow teaches that with a mainframe computer, minicomputer, Local Area Network (LAN) or another computer system at the vendor, the Defined Customer Desires (DCD) may be made available on-line. Harshaw: col. 2, lines 56-67, Harshaw teaches new product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. The Examiner interprets on-line and wide area network as the Internet.).

11. **Claim 20** substantially recites the same limitations as claim 12 with the distinction of the recited method being a system. Hence the same rejection for claim 12 as applied above applies to claim 20.

#### ***Response to Arguments***

12. Applicant's arguments with respect to the 35 USC § 101 rejections set forth in the previous office action have been fully considered and are persuasive. These rejections have been withdrawn.

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13. Applicant's arguments with regards to Abelow et al. (U.S. 5,999,908) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that Abelow et al. does not teach or suggest (1) a business method, per se, (2) discussing among the conceiver of the business method, the company, and if appropriate, at least one additional consumer selected depending on confidentiality, potentiality, and/or urgency of starting a business method.

In response to argument (1), Examiner respectfully disagrees. Abelow et al. discloses that customers assist in developing services offered with the product, such as training, documentation, customer support, financing, volume buy discounts, etc. Customers turn into partners for improving products and services by many means such as improvements in product design, product development, major product upgrades and revisions, improving other product uses, and a variety of business activities. In the broadest reasonable interpretations, a business method is the means or manner of procedure of business or the orderly arrangement of parts or steps to accomplish an end result in business. Gathering of ideas from customers related to the development of services to be coupled with products in order to improve products and services is the gathering of a business method.

In response to argument (2), Examiner points out that she has relied upon van Duyne et al. (U.S. 6,859,784) and not Abelow et al. to teach this limitation. While Abelow discloses implementing a business method conceived by a consumer by participations of consumers, Abelow does not expressly disclose at least one additional consumer other than the conceiver participating in the discussion via the communications network, selected based on confidentiality, potentiality, and/or urgency of starting the business method. Examiner relied on van Duyne et al. to teach that multiple online consumers are selected to provide feedback

regarding company products and areas of improvement, the consumers selected based on potentiality. See the rejections asserted above.

14. Applicant's arguments with respect to the rejections based on Abelow et al. in view of Kozinets (Kozinets, How Online Communicates are Growing in Power, Financial Times, London (UK) 9 November 1998, p. 6 [Proquest]) and with respect to the rejections based on Abelow et al. in view of Kozinets and in further view of Harshaw (U.S. 6,542,871) have been considered but are moot in view of the new grounds of rejection, as necessitated by amendment. Examiner points out that she is no longer relying on Kozinets based on limitations added to the currently pending claims.

#### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737.

The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*bvd*  
bvd

January 5, 2006

  
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